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In re Application of :
UMEDA, Shinji, et al. :
U.S. Application No.: 09/463,144 :
PCT No.: PCT/JP99/02665 :
International Filing Date: 20 May 1999 :
Priority Date: 22 May 1998 :
Attorney's Docket No.: 43890-392 :
For: METHOD OF MANUFACTURING SENSOR :
AND RESISTOR ELEMENT :
: COMMUNICATION
: REGARDING SUBMISSION
: UNDER 37 CFR 1.42

This communication is issued in response to applicants' submission of a declaration executed on behalf of deceased co-inventor Shinji UMEDA by Ieo UMEDA as heir to the deceased inventor.

BACKGROUND

On 20 May 1999, applicants filed international application PCT/JP99/02665 which claimed a priority date of 22 May 1998 and which designated the United States. On 02 December 1999, a copy of the international application was forwarded to the United States Patent And Trademark Office ("USPTO") by the International Bureau ("IB").

A Demand was not filed with the International Preliminary Examining Authority electing the United States prior to the expiration of nineteen months from the priority date. As a result, the deadline for submission of a copy of the international application (unless previously communicated by the IB) and payment of the basic national fee was twenty months from the priority date, i.e., 24 January 2000 (22 January 2000 was a Saturday).

On 20 January 2000, applicants filed a transmittal letter for entry into the national stage in the United States which indicates that it was accompanied by, among other materials, a translation of the international application into English. The transmittal letter also authorized a charge to Deposit Account No. 13-0203 for \$970 (\$840 as the basic national fee and \$130 as the surcharge for filing the declaration after the twenty month deadline), and it noted that the international application had already been transmitted by the IB.

On 11 April 2000, the United States Designated/Elected Office (DO/EO/US) mailed a Notification of Missing Requirements 35 U.S.C. 371 (Form PCT/DO/EO/905) indicating that an

oath or declaration in compliance with 37 CFR 1.497 was required. The Notification also informed applicants that the failure to submit the declaration within one month of the date of the Notification would result in abandonment of the application.

On 11 July 2000, applicants filed a "Response To Notice Of Missing Requirements" accompanied by the declaration considered herein, which has been executed by all of the surviving inventors and by Ieo UMEDA as heir to the deceased inventor. The Response also included supporting materials demonstrating that Ieo UMEDA was the sole heir of the deceased inventor, and a request for a two month extension of time to respond to the Notification Of Missing Requirements (with the required \$380 fee). Based on this extension, applicants' Response is considered timely.

DISCUSSION

37 CFR 1.42 *When the Inventor is Dead*, states, in part:

In case of the death of the inventor, the legal representative (executor, administrator, etc.) of the deceased inventor may make the necessary oath or declaration, and apply for and obtain the patent.

Discussing this provision, section 409.01(a), *Prosecution by Administrator or Executor*, of the Manual of Patent Examining Procedure (MPEP) states, in part (emphasis added):

Application may be made by the heirs of the inventor, as such, if their is no will or the will did not appoint an executor and if accompanied by a certificate from the court that they are **all** of the heirs and that the estate was under the sum required by state law for the appointment of an administrator.

In the declaration submitted here, Ieo UMEDA is identified as "heir" of the deceased inventor. Submitted with the declaration were papers asserting that Ieo UMEDA was the father of the deceased inventor and that, under the circumstances present here and the applicable Japanese law, Ieo UMEDA is the sole heir of the deceased inventor. As the sole heir of the deceased inventor, Ieo UMEDA is entitled to execute the declaration on behalf of the deceased. Accordingly, the declaration submitted here is acceptable under 37 CFR 1.42.

CONCLUSION

The submission under 37 CFR 1.42 is **ACCEPTED**.

This application has an international filing date of 20 May 1999 under 35 U.S.C. 363 and a date of 11 July 2000 under 35 U.S.C. 371(c) and 102(e).

This application is being forwarded to the National Stage Processing Branch of the International Division for treatment in accordance with this decision.



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